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Andrew C. Gilbert

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/982,709
Filing Date: October 18, 2001
Appellant(s): GILBERT, ANDREW
 GILBERT, MARIANN
 STERGIOPOULOS, ANDREW
 STERGIOPOULOS, ANGELA

Antonio Papageorgiou
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 14, 2008.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct

(4) Status of Amendments After Final.

The Appellant's statement of the status of amendments after final rejection contained in the brief is correct

(5) Summary of the Invention.

The summary of the invention contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

Also included in this Answer is the following New Grounds of Rejection.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-2, 4-5, 10-14, 17-18, 23, 25, 30-31, 33-34, 39-43, 46-47, 52, 54, and 106-117 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Based on Supreme Court precedent and recent Federal Circuit decisions, § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. If neither of these requirements is met by the claim(s), the method is not a patent eligible process under 35 U.S.C. § 101.

In this particular case, Claims 1, 14, 30 and 43 closes a mere nominal recitation of technology and fails to transform the underlying subject matter to a different state, therefore the claimed method is non-statutory and rejected under 35 U.S.C. 101 (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)).

Claims 2, 4-5, 10-13, 17-18, 23, 25, 31, 33-34, 39-42, 46-47, 52, 54, and 106-117 are also rejected as each depends from the above rejected claims.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon.

Broka et al., U.S. Patent No. 5,809,483

Togher et al., U.S. Patent No. 5,375,055.

(9) Grounds of Rejection.

The following ground(s) of rejection are applicable to the appealed claims:

Applicant's arguments, with respect to the rejection(s) of claim(s) 1-5, 10-18, 23-25, 30-34, 39-47, 52-54 and 106-117 under 35 U.S.C. 103(a) have been fully considered.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 2-13, 31-42, and 106-117 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "receiving *the* bid to buy the item" (emphasis added).

However, prior to the receiving of the bid, the claim also recites "receiving *a bid command*" and generating an offer to sell based on "at least one of a price and a size for a bid to buy the item...". Therefore, to one of ordinary skill it is not clear which bid is received, the bid command or the bid used to generate the sell offer

(*In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989)). Claim 30 is also rejected as it recites similar language.

Claims 2-13, 31-42, and 106-117 are also rejected as each depends from either claim 1 or claim 30.

The term "better" in claims 109 and 115 is a relative term which renders the claim indefinite. The term "better" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-2, 4-5, 10-14, 17-18, 23, 25, 30-31, 33-34, 39-43, 46-47, 52, 54, and 106-117 are rejected under 35 U.S.C. 103(a) as being unpatentable over Broka et al., U.S. Patent No. 5,809,483 in view of Togher et al., U.S. Patent No. 5,375,055.

As per claims 1-2, 4-5, 10-14, 17-18, 23, 25, 30-31, 33-34, 39-43, 46-47, 52, 54, and 106-117, Broka et al. teach a market trading system comprising:

- receiving a bid command (e.g. data related to a tradable item display) from a trader to buy an item, generating an offer (or bid) based on the submission of a bid (or offer) command from a trader, generating an offer price or size, and receiving the bid and the offer [by the FIPS system] (e.g. generated offer value) (figure 18a)
- using an interactive display, displaying current bid and offer data and receiving a selection of a piece of the bid and offer data as part of the receiving of the bid command (figures 24, 25, and 30; column 16, lines 6-10; column 17, lines 4-14 and 45-67; column/line 19/9-20/6) and selecting a bid (or offer) price from the bid and offer data (i.e. viewing market activity- e.g. bid and offer data, and placing a bid, for example, on a desirable issue at a specific price where the price, or offer, was displayed in the market activity) (figure 18a), displaying the current bid and offer data in a window (figure 20a)
- entering the submission of the bid command via keyboard and using a mouse (column 10, lines 58-63)
- presenting a second trading interface (figures 19 and 20a) that contains information relating to a command (figure 18a) and displaying the interface

in response to the reception of a bid (or offer) command (figures 19 and 20a; column 14, lines 6-12 and 33-45)

- (claims 106-108 and 112-114) an interface screen comprising at least one field for specifying at least one term for a bid to buy and an offer to sell, populating the at least one field to specify for the bid (offer) to buy (sell) the item with the selected price (figures 18 a and b; column/line 13/53-14/5)
- (claims 109 and 115) populating the at least one field (figures 18 a and b; column 15, lines 18-23) for specifying at least one term for the bid to buy the item with a price a predetermined amount better (figures 21 a and b; column 15, lines 35-48) that the selected bid price (figures 18 a and b)
- (claims 110 and 116) an interface screen with a price up button and down button (figures 21 a and b; column 15, lines 35-48)

Broka et al. do not specifically recite submitting an offer command to sell a second size of the item on behalf of the trader wherein the offer is based on the offer value. Togher et al. teach a market maker interface where a market maker makes a bid and an offer of different quantities for the same security, the bid and offer are submitted together (i.e. simultaneously- claims 111 and 117) (figures 3 and 5; column 7, lines 20-23 and 35-40; column 11, lines 6-51) and the bid is based on the offer (and vice versa) (column 7, lines 20-23). Togher et al. also teach a screen display for displaying current bid and offer data using a market cell, spread sheet, data window, entry window or webpage (figures 3 and 5).

Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Broka et al. and Togher et al. in order to accommodate traders using the Broka et al. system ('483, abstract; figures 2, 4, 18a-b, 30 and 39) who desire to take a more active trading role, such as that of a market maker ('055, column 11, lines 6-11).

Regarding, the generating of "offer values", Broka et al. teach quotes as combination "bids" and "asks" (figure 18a; column 4, lines 52-54). Therefore, the Broka et al. system could be used by "market makers" who are willing to buy and sell a given security at a particular price, "arbitrageurs" seeking to capitalize on price differentials in a security, or market participants executing a trading strategy that involves the simultaneous buying and selling of securities. In each instance, a goal is to turn a profit hence, the second transaction (sell if the initial trade was a buy, or buy if the initial trade was a sale) would be based on the first as both transactions are in the same security. Further, it is well known to those of ordinary skill in the buying and selling of securities to determine a transaction position, and profitability, based on spreads is old and well known.

Regarding the coloring of bid and offer data, Broka et al. teach denoting a piece of data using an asterisk (column 14, lines 55-60) or "highlight" (figure 20a). It has been held that changing the way the system of Broka et al. indicates a dealer's own quote by changing color, for example, would have been an obvious modification to one of ordinary skill (*In re Seid*, 73 USPQ 431, 433 (CCPA 1947)).

Regarding “spread sheets”, the use of spreadsheets software (e.g. cells, columns, rows) to prepare bids and offers is old and well-known, therefore it would have been obvious to one of ordinary skill to download data such as current market data (figure 18a) in order to construct a profitable bid/offer strategy. Similarly, displaying data remotely using the internet and its associated technologies (e.g. webpages, html, etc.) is also well known.

New Grounds of Rejection

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-2, 4-5, 10-14, 17-18, 23, 25, 30-31, 33-34, 39-43, 46-47, 52, 54, and 106-117 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Based on Supreme Court precedent and recent Federal Circuit decisions, § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. If neither of these requirements is met by the claim(s), the method is not a patent eligible process under 35 U.S.C. § 101.

In this particular case, Claims 1, 14, 30 and 43 closes a mere nominal recitation of technology and fails to transform the underlying subject matter to a different state,

therefore the claimed method is non-statutory and rejected under 35 U.S.C. 101 (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)).

Claims 2, 4-5, 10-13, 17-18, 23, 25, 31, 33-34, 39-42, 46-47, 52, 54, and 106-117 are also rejected as each depends from the above rejected claims.

(10) Response to Argument.

New grounds of rejection under 35 USC § 101

The Examiner submits that the pending claims are unpatentable under 35 U.S.C. 101, in this particular case, Claims 1, 14, 30 and 43 closes a mere nominal recitation of technology and fails to transform the underlying subject matter to a different state.

Arguments under 35 USC § 112

The Appellant states with regard to independent claims 1 and 30, that the Examiner asserts that it is not clear which bid is received, i.e., the bid command or the bid to generate the offer.

The Examiner submits that there is no clear statement of which bid is received, the bid command or the bid used to generate the sell offer (*In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989)).

The Appellant states that the rejection of claims 109 and 115 alleging the term "better" renders the claim indefinite because there is no standard for ascertaining the requisite degree is in error .

The Examiner submits that there is no support for a quantitative value of the term "better", the Examiner submits that this is an arbitrary term (i.e. the bid might be "better" if received after lunch)

Arguments under 35 USC § 103(a)

The Appellant states that the prior art record fails to disclose generating terms with "a \ pre-set spread amount." However, The Examiner stated that trading based on spreads are old and well known (Office action of November 30, 2005 (page 7). Further, the Appellant did not seasonably challenge (Office action of February 23,2007) the Examiner's assertion, therefore, the Examiner regards such a teaching as an admitted prior art. Furthermore, as evidence the Examiner provided Laborde (US Patent 4,588,192) that discloses spreads for determining positions profitable in transactions. The Laborde reference discloses at column 11, line 42 a detail discussion of "spread theory"; the table show at column 13 discloses example of a transaction with a "pre-set spread amount".

The Appellant states that the prior art record fails to disclose "displaying current bid and offer data in a first interface screen; receiving a bid command from a trader to

buy an item via the first interface screen with a selection of a piece of the bid and offer data displayed, ... and presenting a second interface screen comprising at least one field for specifying at least one term for the bid to buy the item populated with the selected piece of the bid and offer data and at least one field for specifying at least one term of the offer to sell the item populated with the at least one of a price and a size generated for the offer automatically”.

The Examiner responds that the Applicant attempt to further limit the claimed display device by describing what is displayed is representative of non-functional descriptive material as the electronic document is not functionally related to the display device (MPEP 2106 II; *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994)) and therefore cannot be used to differentiate Applicant's device from the prior art as disclosed by Broka.. The Examiner contends the claimed limitations read on two displays respectively pertaining to buying and selling of financial instruments. The Examiner submits that this feature is disclosed by Broka et al., figures 21A and 21B.

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MODIFY QUOTE

SYMBOL AS. GA ARMCO 8.700 1995

PRICE SIZE STATUS FBO

164.00000 200 A 1/8

ASK BID

OK CANCEL

FIG. 21(a)

MODIFY QUOTE

SYMBOL AS. GA ARMCO 8.850 1995

PRICE SIZE FBO STATUS

160.00000 100 WARPMD A 1/8

ASK BID

OK CANCEL

FIG. 21(b)

Regarding the Applicants arguments concerning the lack of Prima Facie showing of claims 14 and 43, the Examiner submits that the Appellant arguments are moot in view of the fact that the limitations that the Appellant discloses are not actually present in the invention as claimed. (i.e. the bid command is received with, i.e., **in response to, a user selecting a** piece of the bid and offer data displayed in the first interface screen. (page 9) and Receiving a bid command **as a result** or otherwise with **the user selecting at least one item of bid** or offer data displayed in the first interface screen is an affirmative act, which is not merely storing data or an intended use. (Page 9). The Examiner notes that invention as claimed merely displays data, and has no limitation involving the selection of data.

Although claims are interpreted in light of the specification, limitations from the specification are not read into the claims In re Van Geuns, 26 USPQ2d 1057 (CA FC 1993)

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

(12) New Grounds of Rejection

This examiner's answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

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Respectfully submitted

John M Winter

/john winter/

Examiner

Art Unit 3685

JMW

August 1, 2008

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/Wynn W. Coggins/

Director, TC 3600

Conferees:

/Calvin L Hewitt II/

Supervisory Patent Examiner, Art Unit 3685

Vincent Millin /VM/

Appeals Practice Specialist